IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Sterling Mortensen

Examiner: Chad Zhong

Serial No.:

09/941,467

Group Art Unit: 2152

Filed:

August 29, 2001

Docket No.: 10004428-1

Title:

DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

REVISED DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. § 1.131

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir/Madam:

This Declaration is submitted to establish prior invention of the subject matter of the present patent application. The person making this Declaration is the inventor, Sterling Mortensen.

Accompanying this Declaration are Exhibits A through J to establish conception of the subject matter of the present patent application prior to the earliest effective date of June 30, 2000 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from just prior to the earliest effective date of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 up to the filing date of the present patent application (i.e., constructive reduction to practice).

Exhibit A (3 pages) includes an HP Invention Disclosure submitted by the inventor Sterling Mortensen and received by the HP Legal Department on June 8, 2000. In addition, this invention disclosure was witnessed on May 22, 2000. This invention disclosure was assigned HP Patent Disclosure No. 10004428 and describes subject matter of the present patent application.

Exhibit B (1 page) includes an email of June 9, 2000 to the inventor Sterling Mortensen informing the inventor that his invention disclosure (#10004428) would be reviewed at a Patent Coordinator Meeting to determine HP's interest in his invention, as well as to determine the urgency of possibly filing for a patent.

Exhibit C (1 page) includes an email of July 6, 2000 to the inventor Sterling Mortensen informing the inventor that he would receive nonwage compensation in accordance with the HP innovation incentive program for his invention {Print To E-Book: PD#10004428}.

REVISED Declaration under 37 C.F.R. § 1.131

Applicant: Sterling Mortensen Serial No.: 09/941,467 Filed: August 29, 2001

Docket No.: 10004428-1

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

Exhibit D (1 page) includes an email of August 29, 2000 to the inventor Sterling Mortensen informing the inventor that the subject invention disclosure was reviewed by the Patent Coordinators Review Committee on August 15, 2000 and that it was determined a patent on the invention would be useful in the pursuit of HP's business interests.

Exhibit E (6 pages) includes a Declaration of patent attorneys Steven E. Dicke and Scott A. Lund of Dicke, Billig, & Czaja, the patent attorneys assigned to prepare the present patent application.

Exhibit F (1 page) includes an email of June 12, 2001 from patent attorney Scott Lund of Dicke, Billig & Czaja to the inventor Sterling Mortensen forwarding a DRAFT of the patent application for review.

Exhibit G (1 page) includes an email of June 28, 2001 from patent attorney Scott Lund of Dicke, Billig & Czaja to the inventor Sterling Mortensen forwarding a REVISED DRAFT of the patent application for review.

Exhibit H (1 page) includes an email of July 11, 2001 from patent attorney Scott Lund of Dicke, Billig & Czaja to the inventor Sterling Mortensen forwarding a FINAL DRAFT of the patent application for review.

Exhibit I (2 pages) includes an initial email of July 13, 2001 from patent attorney Steve Dicke of Dicke, Billig & Czaja to HP Managing Attorney Steven R. Ormiston forwarding a draft of the patent application prepared for HP Patent Disclosure No. 10004428 (DBC H302.152.101) as reviewed and approved for filing by the inventor, and a reply email of July 23, 2001 from HP Managing Attorney Steven R. Ormiston to patent attorney Steve Dicke with comments on the patent application prepared for HP Patent Disclosure No. 10004428.

Exhibit J (1 page) includes a letter dated July 25, 2001 from patent attorney Scott Lund of Dicke, Billig & Czaja to HP Managing Attorney Steven R. Ormiston. This letter was accompanied by a final draft of the patent application based on HP Patent Disclosure No. 10004428 suitable for filing with the USPTO. This patent application was subsequently filed on August 29, 2001.

From these exhibits, it can be seen that the subject matter of the present patent application was conceived prior to the earliest effective date of June 30, 2000 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from

REVISED Declaration under 37 C.F.R. § 1.131

Applicant: Sterling Mortensen Serial No.: 09/941,467 Filed: August 29, 2001

Docket No.: 10004428-1

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

just prior to the earliest effective date of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 up to the filing date of the present patent application (i.e., constructive reduction to practice).

As a person signing below, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 3 August 2005

Sterling Mortensen

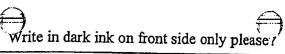
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rite in dark ink on front side only please **INVENTION DISCLOSURE**

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Instructions: The information contained in this document is COMPANY CONFIDENTIAL and may have be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application is authorized, prepared, and submitted to the Government.

Descriptive Title of Invention:	-book			
Name of Project:				
Product Name or Number:			····	· · · · · · · · · · · · · · · · · · ·
Was a description of the invention public	shed, or are you planning to publish? If so, th	e date(s) and publication	on(s):	·
Was a product including the invention as	nnounced, offered for sale, sold, or is such ac	tivity proposed? If so,	the date(s) and	location(s):
Was the invention disclosed to anyone o	outside of HP, or will such disclosure occur?	f so, the date(s) and na	ame(s):	
If any of the above situation	ons will occur within 3 months, call your IP attorney or the	e Legal Department now at ;	1-898-4919 or 970-8	898-4919.
Was are invention described in a lab boo	way on onier records in so, please identity (lab b	ook #, etc.)		
Was the invention built or tested? If so,	the date:			
Was this invention made under a govern	ment contract? If so, the agency and contrac	t number:		
A. Description of the construction and of graphs; flowcharts; computer listings. Advantages of the invention over with the problems solved by the invention.	ove all records of the invention and attach add dated by the inventor(s) and witness(es). Operation of the invention (include appropriates; test results; etc.) hat has been done before.	e schematic, block, & ti	ming diagrams;	
Signature of Inventor(s): Pursuant to m	y (our) employment agreement, I (we) submi	t this disclosure on this	date: [].
25521 Sterling	nortensen Italian Miss	3964	252/14	2 15W (02/a
Employee No. Name	Signature	Telnet	Mailstop	Entity & Lab Name
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INVENTION DISCLOSURE				
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Inventor & Home Address Information: (#	more than four inventors, include addl. in	formation on a copy of this form &	offenh to this decrement	
Inventor's Full Name			allect (to this document)	
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Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es). Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.) e-book Take a document and render it to digital bits which are then stored in a simple e-book for later reading , Have the rendering done by a printer or computer print diber so it looks the same as it will when it is printed. This lets, veriences see how a document will look in printed form before it is printed.

B. Advantages of the invention over what has been done before. Drafts can be reviewed before sending to a large grant site. A simple digital e-book doesn't need a complex rendering system. A document can be rendered once and sent to many Many kinds and formats of source data are conveiled to a vaster digital form, C. Problems solved by the invention. E-book costs can be reduced. Everyone see's the document the same way even if they have e-books from diffrent vendors, D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).



From: HINKLE, BETTY (HP-Boise, ex1) Sent: Friday, June 09, 2000 8:30 AM To: MORTENSEN, STERLING (HP-Boise, ex1)
Cc: WADLEY, DON (HP-Boise, ex1)

Subject: Invention Disclosure

From: Les Murray

Invention Disclosure #10004428 **Subject:**

Title: Print To E-Book

HP appreciates your innovative efforts and that you have reported your invention for management assessment and recording in HP's intellectual property files. This disclosure and other papers and devices describing or embodying the subject matter of this invention should be treated as proprietary to HP and should not be disclosed in any form outside of HP without first consulting with the IP Section of the Legal Department. Such disclosure may destroy our ability to obtain patent protection.

Your invention disclosure will be reviewed at a Patent Coordinator Meeting to determine HP's interest in your invention, as well as to determine the urgency of possibly filing for a patent. To help with this decision, please provide Don Wadley x6-2085, the patent coordinator for your entity. with the following information:

- 1) Based on your knowledge of the state of the art:
- a) What is new or unique about your approach with respect to what was already done?
- b) What relative advantages does your approach have with respect to what was already done?
- Do we presently plan to put this in a product? When will it 2) likely be introduced into the market?

Please call me at X62880 if you have any questions.



From: LEE,RUSSELL (Non-HP-Boise,ex1)
Sent: Thursday, July 06, 2000 7:45 AM
To: MORTENSEN,STERLING (HP-Boise,ex1)

Subject: [Inovation incentive {Disclosure email to inventor} PD#

{10004428}]

The purpose of this email is to let you know that \$100.00 (Tax Protected) has been entered into the nonwage compensation system for your invention {Print To E-Book: PD#10004428} in accordance with the HP innovation incentive program (see http://legal.hp.com/patenttm/index.htm).

It takes approximately a week for the nonwage compensation system to process the payment data that have been entered for this innovation incentive. You should see your money on the next paycheck thereafter. If you do not receive a deposit on that pay check, please forward this email message to bill_meade@am.exch.hp.com with a brief explanation of what paycheck date the payment missed.

Thanks!

Bill Meade Intellectual Property Portfolio Manager Hewlett-Packard IPS bill_meade@ am.exch.hp.com T396-3145



From: WALKER, TERRI (HP-Boise, ex1)
Sent: Tuesday, August 29, 2000 5:49 AM
To: MORTENSEN, STERLING (HP-Boise, ex1)

Subject: Invention Disclosure

From: Les Murray

Subject: Invention Disclosure 10004428

Title: Print to E-Book

Your subject invention disclosure was reviewed by the Patent Coordinators Review Committee on August 15, 2000. It was determined a patent on your invention will be useful in the pursuit of HP's business interests.

Accordingly, your assistance will be needed in the development of a patent application covering your invention. Steve Dicke will be requested to prepare the patent application and you should be contacted within the next month or so as the application process is initiated.

HP relies heavily on the innovative developments of its members of the technical staff to produce new and better products. Your inventions are important and are greatly appreciated, whether or not selected for patenting. All HP personnel are encouraged to continue to develop and disclose their creative ideas to help HP in remaining competitive.

Any questions you may have with respect to this matter should be directed to me at the IP Section of the Legal Department at x 6-2880.

/tw



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:

Sterling Mortensen

Examiner: Chad Zhong

Serial No.:

09/941,467

Group Art Unit: 2152

Filed:

August 29, 2001

Docket No.: 10004428-1

Title:

DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

DECLARATION OF STEVEN E. DICKE AND SCOTT A. LUND

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir/Madam:

This Declaration is submitted in support of the Revised Declaration of Prior Invention Under 37 C.F.R. 1.131 submitted to establish conception of the subject matter of the present patent application prior to the earliest effective date of June 30, 2000 of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 coupled with due diligence from just prior to the earliest effective date of the McCurdy et al. U.S. Patent Application Publication No. 2002/0035697 up to the filing date of the present patent application (i.e., constructive reduction to practice).

The persons making this Declaration are patent attorneys Steven E. Dicke and Scott A. Lund of Dicke, Billig & Czaja. We state as follows:

On September 1, 2000, Steven E. Dicke received HP Invention Disclosure No. 10004428-1 from HP Patent Attorney-Outsourcing Manager Steven R. Ormiston (see Attachment 1). Upon receiving the invention disclosure, it was placed in queue to be prepared.

On September 1, 2000, Steven E. Dicke signed a Request for Quote and Engagement Letter Agreement for the preparation of a US Patent Application based on HP Invention Disclosure No. 10004428-1 (see Attachment 2). The agreement was subsequently signed by Steven R. Ormiston of HP on September 5, 2000.

During the period between approximately September 5, 2000 and May 15, 2001, we had a reasonable backlog of unrelated cases on which we worked reasonably hard and carried out expeditiously. Our practice was to attend to the preparation of patent applications having bar dates first and attend to the preparation of the remaining patent applications (including the present patent application) generally in the chronological order in which they were received.

Declaration of Steven E. Dicke and Scott A. Lund

Applicant: Sterling Mortensen

Serial No.: 09/941,467 Filed: August 29, 2001 Docket No.: 10004428-1

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

On May 15, 2001, Scott A. Lund reviewed the invention disclosure and searched and reviewed background documents (see Attachment 3).

On May 17, 2001, Scott A. Lund conducted an inventor conference with the inventor (see Attachment 3).

Between at least May 25, 2001 and June 26, 2001, Scott A. Lund drafted and prepared the present patent application (see Attachment 3).

As a person signing below, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name:

Date: Aug. 3, 2005





Hewlett-Packard Company LEGAL DEPARTMENT 11307 Chinden Boulevard Boise, Idaho 83714 (208) 396-4038

H-Pis Filing

ATTACHMENT |



August 29, 2000

Steven E. Dicke, Esq. Dicke, Billig & Czaja PA Suite 1250 701 Building 710 Fourth Avenue South Minneapolis, MN 55415

Re:

Preparation and Filing of Patent Application

Pursuant to Outside Counsel Procedures dated October 15, 1999

HP Invention Disclosure PD No. 10004428-1

Entitled: "Print to E-Book"
Inventor(s): Sterling Mortensen

Dear Steve:

We would like you to provide us with a quote of the cost for your firm to prepare a US patent application based on the HP invention disclosure identified above, a copy of which is enclosed. Your quote should be based on preparing and supplying us with the completed application, formal drawings, and a disk containing the electronic file for the application all to be received by the HP required receipt date stated above.

Your quote should be submitted on the enclosed Request for Quote And Engagement Letter Agreement. If your quote is accepted, we will return a fully executed copy of the Agreement to you for your records. The Agreement will not be binding on you or on HP until signed by HP's authorized representative.

If this Agreement is not signed and returned to HP, any bills submitted by you cannot be paid.

Thank you for your assistance in reviewing the invention disclosure. If your review indicates a possible conflict for your firm, you should advise us within one week of receipt of this letter.

Walker for Steven R. Orniston

Sincerely yours,

Steven R. Ormiston

Patent Attorney - Outsourcing Manager

SRO/tw

Enc: Invention Disclosure

Request for Quote/Agreement

Request for Quote and Engagement Letter Agreemer.

RE: Hewlett-Packerd Docket No. 10004428-1

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DICKE, BILLIG			LETT-PACKARD COMPANY
By:	ven E. Duke	By Steve	en R. Ormiston
Dated: 9	11/00	Dutsd:	2/5/00



DICKE, BILLIG & CZAJA, PLLC

Patent • Trademark • Copyright ATTORNEYS

Fifth Street Towers • 100 South Fifth Street • Suite 2250 • Minneapolis, Minnesota 55402 Telephone: (612) 573-2000 Facsimile: (612) 573-2005

Page: 1 07/01/2001

Account No: 302-152101M

Invoice No:

Hewlett-Packard Company Financial Administrator - PMHP Legal Dept. M/S 1068 HP Development Co, LP, PO Box 10301 Palo Alto CA 94303-0890 U.S.A.

Attn: Steve Ormiston

PRINT TO E-BOOK 10004428-1

Fees

		Rate Hours
05/15/2001 SAL	reviewing invention disclosure; searching and reviewing background documents	
05/17/2001 SAL	preparing for and in inventor conference; searching and reviewing background documents	
05/25/2001 SAL	drafting claims for patent application	
05/29/2001 SAL	drafting claims and preparing specification for patent application	
06/11/2001 SAL	preparing drawings and specification for patent application	
06/12/2001 SAL	preparing specification for patent application	
06/13/2001 SAL	preparing specification for patent application	
06/14/2001 SAL	preparing specification for patent application	
06/15/2001 SAL	preparing specification for patent application	
06/26/2001 SAL	discussing patent application with inventor; editing patent application	
	For Current Services Rendered	

Expenses

06/30/2001 Miscellaneous expenses including long distance phone

Page: 2 07/01/2001

Account No: 302-152101M

Invoice No:

13878

ATTACH MENT 3

PRINT TO E-BOOK 10004428-1

06/11/2001

charges, facsimile charges, photocopies and postage.

Total Expenses

Advances

Illustrating fees - patent drawings.

Total Advances

Total Current Work

Balance Due

Task Code Recapitulation

*** Task Code Not Found ***



Terms: Balance Due upon Receipt

F.I.N. 52-2386944

Questions? Please call Mary Anderson at (612) 573-0079.

E-mail: manderson@dbclaw.com



From: Scott Lund [mailto:slund@dbclaw.com]
Sent: Tuesday, June 12, 2001 1:32 PM
To: MORTENSEN,STERLING (HP-Boise,ex1)
Subject: HP10004428 - DRAFT patent application

Sterling -

Attached for your review is a DRAFT patent application based on Invention Disclosure HP10004428 entitled "Print to E-Book".

The attached files have been password protected and include a WORD document and a PDF file of drawings. I will leave a voicemail message for you with the password (Note: the password is in ALL CAPS). If you have any problems retrieving the files, please call.

After your review, please call/email with your comments.

Thanks, Scott

Scott A. Lund Dicke, Billig & Czaja, P.A. Suite 1250, 701 Building 701 Fourth Avenue South Minneapolis, MN 55415

Tel: 612.573.2006 Fax: 612.573.2005

E-mail: slund@dbclaw.com



From: Scott Lund [mailto:slund@dbclaw.com] Sent: Thursday, June 28, 2001 10:38 PM

To: sterling_mortensen@hp.com

Subject: HP10004428 - REVISED DRAFT patent application

Sterling -

Attached for your review is a REVISED DRAFT patent application (with changes "tracked") based on Invention Disclosure HP10004428 entitled "Print to E-Book". (To conceal "tracked changes" select TOOLS>TRACK CHANGES>HIGHLIGHT CHANGES...)

The attached files have been password protected and include a WORD document and a PDF file of drawings. (Note: password is SAME as before and in ALL CAPS).

Please call/email as soon as possible with your approval/comments.

Thanks, Scott

Scott A. Lund Dicke, Billig & Czaja, P.A. Suite 1250, 701 Building 701 Fourth Avenue South Minneapolis, MN 55415

Tel: 612.573.2006 Fax: 612.573.2005

E-mail: slund@dbclaw.com



From: Scott Lund [mailto:slund@dbclaw.com]
Sent: Wednesday, July 11, 2001 11:32 AM
To: MORTENSEN,STERLING (HP-Boise,ex1)

Subject: HP10004428 - FINAL DRAFT patent application w/ PSWRD

Sterling -

Attached is a FINAL DRAFT patent application (with changes "tracked") based on Invention Disclosure HP10004428 entitled "Print to E-Book".

The attached file has been password protected (Note: password is SAME as before and in ALL CAPS).

Please call/email as soon as possible with your approval/comments.

Thanks, Scott

Scott A. Lund Dicke, Billig & Czaja, P.A. Suite 1250, 701 Building 701 Fourth Avenue South Minneapolis, MN 55415

Tel: 612.573.2006 Fax: 612.573.2005

E-mail: slund@dbclaw.com

100



Scott Lund - RE: HP10004428-1; H302.152.101

From:

"ORMISTON,STEVEN (Non-HP-Boise,ex1)" <steve_ormiston@non.hp.com>

To:

Steve Dicke <sdicke@dbclaw.com>

Date:

7/23/2001 2:27 PM

Subject:

RE: HP10004428-1; H302.152.101

CC:

"Angela Tollerud (E-mail)" <angela_tollerud@non.hp.com>

Steve,

I had a couple comments which are noted in the attachment. I don't need to see the case again. Steve Ormiston.

Steven R. Ormiston
Outsourcing Manager, Patent Attorney
Hewlett-Packard Co.
Boise, ID
(208) 396-2544
steve_ormiston@non.hp.com

----Original Message----

From: Steve Dicke [mailto:sdicke@dbclaw.com]

Sent: Friday, July 13, 2001 2:45 PM To: steve_ormiston@non.hp.com

Cc: Jolene Neby

Subject: HP10004428-1; H302.152.101

Hi Steve-

Attached is a draft application including drawings for your review and comments. This draft has been approved by the inventors.

Please confirm receipt of this application via reply email.

Regards,

Steven E. Dicke

DICKÉ, BILLIG & CZAJA, P.A. 701 Fourth Ave. South, Suite 1250 Minneapolis, MN 55415

Tel: 612.573.2002 Fax: 612.573.2005

Email: sdicke@dbclaw.com

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Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415 Telephone: (612) 573-2000 Facsimile: (612) 573-2005

Scott A. Lund Direct Dial: (612) 573-2006

July 25, 2001

Mr. Steven R. Ormiston
HEWLETT-PACKARD COMPANY
Legal Department, M/S 314
11311 Chinden Boulevard
Boise, ID 83714

<u>VIA FEDERAL EXPRESS</u>

RE:

U.S. Patent Application for:

DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

HP File No: 10004428-1 DBC File No.: H302.152.101

Dear Steve:

Please find enclosed the following U.S. Patent Documents suitable for filing with the U.S. Patent and Trademark Office of the above-referenced patent application:

- Hard copy of Patent Application and Formal Drawings;
- Electronic copy of Patent Application and Formal Drawings on CD-ROM;
- Form PTO-1449; and
- Six (6) cited references.

If you have any questions regarding this matter, please contact me at (612) 573-2006.

Regards,

DICKE, BILLIG & CZAJA, P.A.

SAL:jan

Enclosures

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